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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/386,183

Applicant(s)

Ro

Examiner

Boccio, Vincent

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 21, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 50-81 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 08/498,585.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. Claims 50-81 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly presented independent claims 50, 56, 60, 61, 68, 77, 75 and 76, and all dependent claims recite:

claim 50, recites,

"the external device when attached to the detachable storage unit, but detached from reproduction unit;

cannot reproduce data from the detachable storage unit"

claim 56, recites,

"the external device when attaches to the detachable storage unit, but, detached from the reproducing device, cannot reproduce data from the detachable storage unit;

claim 60, recites,

"wherein the recording device when attached to the detachable storage unit, but, detached from the external device, cannot reproduce from the detachable storage unit;

claim 61 recites,

"wherein the recording device when attached to the detachable storage unit, but detached from the reproduction unit, cannot reproduce data from the detachable storage unit;

claim 68 recites,

"the external device when attached to the detachable storage unit, but detached from the reproduction unit, cannot reproduce data from the detachable storage unit;

claim 72 recites,

"wherein the external device when attached to the detachable storage unit, but detached from the reproduction unit, cannot reproduce data from the detachable storage unit;

claim 75, recites,

"wherein the recording device when attached to the detachable storage unit, but detached from the external device, cannot reproduce data from the detachable storage unit;

claim 76 recites,

"wherein the recording device when attached to the detachable storage unit, but detached from the reproducing unit, cannot reproduce data from the detachable storage unit".

With respect to applicant's disclosure, this limitation functionality associated with, when attached to the detachable storage unit, but detached from the reproduction unit and not being able to reproduce data from the detachable storage unit, without the reproduction unit being attached, this recited functionality is not present in applicant's disclosure.

According to page 10, col. 4, it is clear that in Fig. 1, unit 1, **can reproduce the data stored in the detachable memory unit to memory 13**, of unit 1, with no regard to whether unit 2 or the reproduction unit 2 is also connected, as shown on Fig. 1.

The recording unit or external device when attached to the detachable memory unit and detached from the reproduction unit,

can clearly can reproduce recorded digital data from the detachable memory unit, to the external device or unit 1, memory 13, as provided and clearly shown in Fig. 1, page 10, col. 4 etc.....

Therefore, the limitations as recited is considered to be new matter for not clearly disclosing in the original specification the recited limitations in all the claims.

**Response to Arguments**

3. Applicant's arguments with respect to newly presented claims 50-81 have been considered but are moot in view of the new ground(s) of rejection.

Applicant had provided an area to support the limitations as amended to, cited on page 9, col. 3, lines 57-67, which recites,

"Next the operation of the data recording unit 1 for recording data is described in detail.

To output and/or input data from the memory 13 to the separable storage unit or to store an analog signal through the data compressor 11 to the memory 13, information corresponding to each mode must be input from the data selector 15.

Accordingly the input to the microcomputer 22 from the Keyed input unit 27, that is, the information corresponding to each mode, is input to the data selector 15 from the microcomputer 22."

It is the examiner's opinion that this area of the specification fails to disclose the recited limitations as recited in the claims.

**IN RESPONSE TO THE REQUEST FOR AN INTERVIEW**

The request for an interview has been acknowledged, but, it is noted there has been granted a previous interview on 10/18/2001.

Since an amendment has already been filed and received, the examiner only after a careful consideration, search and some time, will be able to determine whether patentability of the claims is warranted.

Therefore, is the examiner's opinion that any further interviews should be based on, "proposed claim language", provided with proposed arguments prior to the interview for review by the examiner, associated with all rejections and all art of record.

**Conclusion**

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Fax Information**

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communication intended for entry)

**or:**

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

5. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vin  
December 18, 2002

*Vincent F. Boccio*  
VINCENT BOCCIO  
PRIMARY EXAMINER